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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,103	01/17/2002	Takeshi Miyakawa	217829USOPCT	2093

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EXAMINER

NOLAN, SANDRA M

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/030,103

Applicant(s)

MIYAKAWA ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claims***

1. Pursuant to entry of the Preliminary Amendment dated 17 January 2002 (Paper No. 5), claims 1-11 are pending.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 17 January 2002 (Paper No. 3) was considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-3 are rejected under 35 U.S.C. 102(a) as being anticipated by Kadoya (Hei 11[1999]-77938).

Kadoya teaches laminated sheets (title) for packaging (page 2, par. 0001) with PC/(PET and PC)/PC structure, wherein PC is polycarbonate and PET is polyethylene terephthalate (page 4, par 0011). At page 7, par. 0021, it teaches antistatic coatings. The sheets are useful in containers that are to be heated (page 2, par. 0001).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 4-10 are rejected under 35 U.S.C. 103(a) as being obvious over Kadoya taken with JP 05294476A (abstract).

The Kadoya reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the

reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Kadoya is discussed above.

It fails to teach conductive sheets on its surface.

JP 05294376A (JP-376) teaches carrier tapes for packaging electronics having conductive sheets embossed on thermoplastic sheets (first paragraph of abstract). The conductive sheets help protect electronics packaged therein from damage by static electricity (use/advantage section)

The references are analogous because they both deal with thermoplastic sheets having protective coatings/layers thereon.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the conductive sheets of JP-376 as protective layers for the sheets of Kadoya in order to make them suitable for packaging electronics.

The motivation to employ the sheets of JP-376 on the sheets of Kadoya is found in the use/advantage section of the JP-376 abstract, where the conductive sheets are taught to help protect electronics packaged therein from damage by static electricity.

The selection of conductive sheets having appropriate resistivities is a matter of optimization of properties.

8. Claims 4-10 are rejected under 35 U.S.C. 103(a) as being obvious over Kadoya taken with Kitaoka (JP 11-147569).

The Kadoya reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Kadoya is discussed above.

It fails to teach the use of antistatic layers having the claimed resistivities.

Kitaoka teaches that antistatic layers having resistivities of  $10^7$  to  $10^{12} \Omega / \square$  (claim 2) are conventional in tapes (title) for packaging electronics (page 1, last line). At page 3, par. 0004, it teaches that the tapes have antistatic effects and are sealable.

The references are analogous because they both deal with thermoplastic sheets having protective coatings/layers thereon.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the antistatic layers of Kitaoka on the sheets of Kadoya in order to produce packaging for electronics.

The motivation to employ the antistatic layers of Kitaoka on the sheets of Kodaya is found at page 3, par. 0004 of Kitaoka, where its tapes are said to be sealable and antistatic.

It is deemed desirable to make electronics packaging sheets/tapes that are sealable and antistatic in order to package the electronics easily and protect them from static charges.

9. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al (US 5,208,103) in view of Kadoya.

Miyamoto teaches laminated (Figure 1) cover tapes for electronic packaging (title) that is heat-sealable to plastic carrier tape (abstract).

Kadoya is discussed above.

The references are analogous because they both deal with packaging laminates.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the laminated sheets of Kadoya as the carrier tape in the packaging of Miyamoto in order to insure that the carrier tape will survive heat treatment, e.g., during heat sealing.

The motivation to employ the sheets of Kadoya as the carrier tapes in the packaging of Miyamoto is found at page 2, par. 0001 of Kadoya, where the use of its sheets in packaging that is to be heated is taught.

It is deemed desirable to make electronics packaging that can be heat sealed or otherwise subjected to heating in order to insure that the packaging will adequately protect the packaged electronics.

***Conclusion***

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.



S. M. Nolan  
Patent Examiner  
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SMN/smn  
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